

Office Action Summary

Application No.

09/391,783

Applicant(s)

Baldwin et al.

Examiner

Grace Hsu, Ph.D.

Group Art Unit

1627



☒ Responsive to communication(s) filed on Jun 9, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11, 453 O.G. 213.

A shortened statutory period for response to this action is set to expire one month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 4-14 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 4-14 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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DETAILED ACTION

Please Note: In an effort to enhance communication with our customers and reduce processing time, Group 1627 is running a Fax Response Pilot for Written Restriction Requirements. A dedicated Fax machine is in place to receive your responses. The Fax number is (703) 305-3704. A Fax cover sheet is attached to this Office Action for your convenience. We encourage your participation in this Pilot program. If you have any questions or suggestions please contact Jyothisna Venkat, Supervisory Examiner at Jyothisna.Venkat@uspto.gov or 703-308-2439. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.

1 Claims 4-14 are pending and claims 1-3 and 15-37 were canceled in the instant application.

2 An Supplemental Preliminary Amendment Under 37 C.F.R § 1.121(a) received on June 9, 2000 was entered as Paper No. 4.

3 In light of applicants June 9, 2000 Amendment, a new restriction requirement is set forth below.

Election/Restriction

4 Restriction to one of the following inventions is required under 35 U.S.C. § 121:

- I. Claims 4-7, drawn to a compound of formula II, classified in class 549, subclass 16+.
- II. Claims 8-10, drawn to a compound of formula IIa, classified in class 546, subclass 61+.
- III. Claims 11-12, drawn to a compound of formula IIb, classified in class 546, subclass 62+.
- IV. Claims 11-12, drawn to a compound of formula IIc, classified in class 546, subclass 62+.
- V. Claims 11-12, drawn to a compound of formula IId, classified in class 549, subclass 42+.
- VI. Claims 13-14, drawn to a compound of formula and structure as defined in claim 13, classified in class 544, subclass 32+

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5. The inventions are distinct, each from the other, because of the following reasons:

6. Groups I-VI represent separate and distinct inventions. Groups I-VI are drawn to different compounds (as represented by different chemical structures, which have different chemical and physical properties that may have different biological, therapeutic or other functional uses). Therefore, Groups I-VI have different issues regarding patentability and enablement and represent patentably distinct subject matter, which merits separate and burdensome searches.

7. These inventions are distinct for the reasons above and have acquired a separate status in the art because of their recognized divergent subject matter and/or shown by their different classifications. While some of the aforementioned groups are classified under an identical class/sub-class, the corresponding non-patent literature search remains unaffected. Each of the identified groups may require different searches. For example, methods and products groups require different searches. Therefore, restriction for examination purposes as indicated is proper.

8. This application contains claims directed to the following patentably distinct species of the claimed invention.

9. Applicants are advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

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Each of the species identified in claims above represents patentably distinct subject matter. In the instant case, those species each involve different structures and modes of action. Therefore, those species involve different patentability and enablement issues.

Moreover, applicants are required in Groups I-VI, claims 4-14 to elect **a single compound species**, wherein each of the functional groups of the core formula, i.e., for example R, R₁, R₂, R₃, R₄, R₅ etc. and each respective sub-group of any of the chemical formulas defined in those respective Groups I-VI therein should be defined.

Applicants are required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 1 is generic.

For search purposes, applicants should provide the chemical structure of a single compound species, wherein specific chemical formula substituents of attached to the core formula are defined either by picture or by expressing the species in terms of the variables of the formula.

10. Upon the allowance of a generic claim, applicants will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicants must indicate which are readable upon the elected species. MPEP § 809.02(a).

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11. Should applicants traverse on the ground that the species are not patentably distinct, applicants should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

12. Applicants are advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

13. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Conclusion

14. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Grace C. Hsu, Ph.D., J.D. whose telephone number is (703) 308-7005. The Examiner may be reached during normal business hours, Monday through Friday from 8:30 am to 5:30 pm (EST). A message may be left on the Examiner's voice mail.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Jyothsna Venkat, may be reached at (703) 308-2439. The fax number assigned to

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Group 1627 is (703) 305-4242. Any inquiry of a general nature or relating to the status of this application should be directed to the Group 1627 receptionist whose telephone number is (703) 308-0196.

Grace C. Hsu, Ph.D., J.D.

June 18, 2000

BENNETT CELSA
PRIMARY EXAMINER

Bennett Celsa